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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,030	05/02/2006	Paul Nicholas Roger Isaacs	1031-003	8329
27820 7590 09/06/2007 WITHROW & TERRANOVA, P.L.L.C. 100 REGENCY FOREST DRIVE SUITE 160 CARY, NC 27518			EXAMINER BOSWELL, CHRISTOPHER J	
			ART UNIT 3676	PAPER NUMBER
			MAIL DATE 09/06/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/578,030

**Applicant(s)**ISAACS, PAUL NICHOLAS  
ROGER**Examiner**

Christopher Boswell

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,12-15 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,12-15 and 20-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9, 13-15 and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication Number 2002/0178771 to Porter.

Porter discloses a lock, comprising a lock mechanism (14) capable to receive and lock to an associated keep (30), an outer cover (84) which extends over both the lock mechanism and the keep when the keep is locked to the lock and which prevents access to both the lock mechanism and the keep (plate 84 is capable of extending past the gap between the doors to cover the hasp), a bolt (20) capable to engage with the keep, wherein the bolt is movable by manual operation by a user from a release position in which it extends outside the lock to a locking position in which it engages the keep (via key 40 inserted into keyhole 94), a latching mechanism (100) including a deadlock (104) capable to engage the bolt in the locking position, and electronic circuitry (120 and 122, as well as power supply 124) comprising an antenna (120) capable to receive an authorization signal from a smart card (118), a transceiver (122) capable to process the authorization signal received from the smart card, and control means (the microprocessor that communicates with the transceiver) housed within the lock capable to operate the latching

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mechanism in response to the transceiver processing the authorization signal (paragraph 44), as in claim 1.

Where it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation by only requires the ability to so perform. It does not constitute a limitation in any patentable sense. And is therefore not given any patentable weight in the claims. *In re Hutchinson*, 69 USPQ 138.

Porter also discloses the electronic circuitry has a keypad (126) aligned with an aperture (94) in the outer cover permitting the lock to be operated when a correct code is entered on the keypad (paragraph 45), as in claim 9, where the bolt comprises a cylinder lock (44) capable of releasing the lock manually when operated by a correct key (40), as in claims 13 and 25, as well as the electronic circuitry controls an actuator (98), via the control means, which releases the latching mechanism, as in claims 14 and 23, wherein the actuator is a piezoelectric actuator (paragraph 44), as in claims 15 and 24, and further comprising a follower (92) capable of displacing the latching mechanism, wherein the mechanical security cylinder further comprises a cam face (cutout in element 94 that receives the follower) capable of displacing the follower to cause the follower to displace the latching mechanism, as in claim 26.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Porter, as applied above, in view of U.S. Patent Number 4,509,350 to Gartner.

Porter discloses the invention substantially as claimed. Porter discloses the cover providing a solid reinforcing plate that would have to be defeated before the latching assembly components could be tampered with plate (paragraph 40). However, Porter does not disclose the properties of the cover that provide the reinforcing structure. Gartner teaches of a locking assembly (10) with an external cover (31) that is enhanced through the provision of the addition of non-drillable material, specifically, a material such as chips of hard material such as carbide or ceramic chips, (column 3, lines 16-33) in the analogous art of secure locking assemblies that are mounted on the exterior of a door for the purpose of providing protective means for preventing and impeding the unauthorized intrusion into the lock as by drilling through a safe door. It would have been obvious to one with ordinary skill in the art at the time the invention was made to profile the cover to an extent, i.e. 20 mm, so that a cutting or grinding disk would be required to sever the components within the lock, as well as incorporate the design of a cover as taught by Gartner, into the cover of Porter, such that the cover would comprise dissimilar materials, such as ceramic or hardened steel, that could further clog a cutting or grinding wheel, as well as the cover protecting the lock from the weather in order to provide protective means for preventing and impeding the unauthorized intrusion into the lock as by drilling through an exterior surface of the lock.

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Claims 12, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter, as applied above, in view of U.S. Patent Number 6,486,793 to Buccola.

Porter discloses the invention substantially as claimed. However, Porter does not disclose a wake-up mode or a sleep mode for the electronic circuitry. Buccola teaches a lock having a latching mechanism (14) and electronic circuitry comprising an antenna (32) to receive an authorization signal, a transceiver (38) to process the authorization signal, and control means (54) housed within the lock, wherein the electronic circuitry comprises a wake up mode (50) which is activated by the user operating the bolt, wherein the control means is further adapted to operate the latching mechanism in response to the wake up mode of the electronic circuitry being activated (column 4, lines 37-51), as in claims 12 and 20, and conversely when the circuitry is not in a wake-up condition, it is capable of being in a sleep mode, as in claim 21, in the analogous art of electrically controlled locking systems for the purpose of preventing unnecessary drain of power from the power supply (column 4, lines 37-45). It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a wake-up mode and a sleep mode, as taught by Buccola, into the electronic circuitry of Porter, such that when the circuitry is not in an active condition, the system would "sleep" until a wake-up mode is activated in order to prevent unnecessary drain of power from the power supply.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porter, as applied above, in view of U.S. Patent Application Publication Number 2004/0108734 to Maple et al.

Porter discloses the invention substantially as claimed. However, Porter does not disclose a spring to resiliently bias the bolt. Maple et al. teaches of a bolt assembly (24) attached

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to a closure (13) having a bolt (25) that is received in an opening or keep, and a spring (paragraph 27) in the analogous art of sliding latch bolt assemblies for the purpose of maintaining the bolt in its withdrawn position, unless driven forwardly against the action of the spring. It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a spring into the latching mechanism of Porter, as taught by Maple et al., where the spring would be disposed around the bolt and biasing the bolt into an unlocked position in order to maintain the bolt in a withdrawn position, unless driven forwardly, by displacement of the follower, against the action of the spring.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-15 and 17-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to electrically retained locking assemblies:

U.S. Patent Number 7,076,976 to Goldman, U.S. Patent Number 6,705,136 to Porter, U.S. Patent Number 6,666,054 to Hsieh, U.S. Patent Number 5,492,382 to McBride et al., U.S. Patent Number 5,216,909 to Armoogam, U.S. Patent Number 4,784,415 to Malaval.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Boswell whose telephone number is (571) 272-7054. The examiner can normally be reached on 9:00 - 4:00 M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on (571) 272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher Boswell  
Examiner  
Art Unit 3676

  
Suzanne Dino Barrett  
Primary Examiner

CJB   
August 29, 2007